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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
060091.00217

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Signature _____

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Name _____

Application Number:

10/629,910

Filed: July 30, 2003

First Named Inventor:

Roy LILLQVIST

Art Unit: 2164

Examiner: Charles D. ADAMS

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

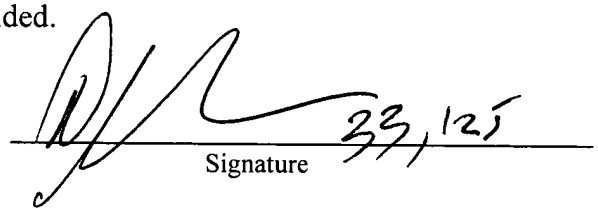
I am the

☐ Applicant/Inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96)

☒ Attorney or agent of record.
Registration No. 58,178

☐ Attorney or agent acting under 37 CFR 1.34.
Registration Number if acting under 37 CFR 1.34



Signature

Peter Flanagan
Typed or printed name

703.720.7864
Telephone number

November 24, 2008
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:
Roy LILLQVIST, *et al.*
Application No.: 10/629,910
Filed: July 30, 2003

Confirmation No.: 6100
Art Unit: 2164
Examiner: Charles D. Adams
Attorney Dkt. No.: 060091.00217

For: ENHANCEMENT OF DATABASE PERFORMANCE IN A DOMAIN NAME SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 24, 2008

Sir:

Applicants hereby submit this Pre-Appeal Brief Request for Review ("PABRR") of the final rejections of claims 1-15 and 21-27 in the above identified application. Claims 1-15 and 21-27 were finally rejected in the Final Office Action dated July 23, 2008 ("Office Action"). Applicants filed a Response to the Office Action on September 23, 2008 ("Applicants' Response"). Clear errors exist in these final rejections, which warrant withdrawal of the rejections. The Office issued an Advisory Action dated October 17, 2008 ("Advisory Action"). Applicants hereby appeal these rejections and submit this PABRR. A Notice of Appeal is timely filed concurrently herewith.

Applicants respectfully submit that there remains clear error in every remaining rejection. Claim 13 was rejected under 35 U.S.C. 101, but this issue is no longer presented for appeal, because claim 13 has been cancelled without prejudice or disclaimer.

Claims 1-2, 8-15, 21, and 27 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,557,045 of Tsukui et al. ("Tsukui"). This rejection includes clear error.

Tsukui generally relates to an apparatus for editing an e-mail address and an e-mail apparatus. The e-mail apparatus of Tsukui includes a memory to which a character string showing a domain name is stored, and a display for dividing an e-mail address into several segments including a segment of the domain name so as to be displayed, and for displaying the character string of the domain name stored in the memory at the segment of the domain name. The apparatus also includes a button for changing the domain name displayed on the display to

other domain name stored in the memory and a dividing section, which is configured to divide the character string of the e-mail as a sender included in the received e-mail into a plurality of segments. The apparatus also includes a storing section, which is configured to store the character string corresponding to the segment of at least the domain name in the divided character, to the memory.

Claim 1 recites, in part, "receiving data to be supplied to database operations, the data including at least one Internet domain name comprising a plurality of successive labels separated by dots, said at least one Internet domain name being in a first format, wherein the at least one Internet domain name comprises at least one hostname and at least one top-level domain name." Tsukui fails to disclose or suggest at least these features of claim 1.

Tsukui fails to disclose receiving any data to be supplied to **database operations**. In fact, Tsukui fails to disclose any database or operations pertaining to databases. It should be noted that *e.g.* the edition RAM 104 of Tsukui simply provides a work area for editing an e-mail address (as explained at column 3, lines 15-16, of Tsukui). Thus, edition RAM 104 of Tsukui corresponds to a regular, conventional random access memory of a computer apparatus, which – as such – does not constitute any kind of database.

The Advisory Action asserted, "In this case, the edition RAM stores data ... All of these memories are databases." Applicants respectfully disagree. The term "database" by definition and as it would be understood by a person of ordinary skill in the art refers to a (usually large) collection of interrelated data organized especially for rapid search and retrieval. However, the term "memory," for example, RAM, as understood by one of ordinary skill in the art, refers to a physical entity capable of storing data. While a memory could be used for storing such an organized collection of data that constitutes a database, a memory is not itself, as such, a database.

In other words, the terms memory and database are already conceptually on different levels: a physical entity for storing any information (memory) vs. an organized collection of information (database). In addition, even if some data, such as an email address, is stored in a memory for editing purposes, that does not automatically constitute a database. It would be appreciated by one of ordinary skill in the art that a memory could be used for storing, in a non-

organized or disorganized manner, many kinds of information such as text files or image files, without resulting in the formation of a database.

Because claim 1 was rejected as anticipated by Tsukudi, it is necessary for the Office Action to demonstrate that a memory clearly does correspond to a database, even despite the complete silence of Tsukudi as to any collection of organized data that would constitute a database. Without such a demonstration, it is clear that Tsukui does not anticipate a database. Thus, the standard "to anticipate a claim, the reference must teach every element of the claim" (MPEP 2131) has not been met.

Claim 1 also recites, in part, "conditionally converting at least one of said at least one Internet domain name into a second format of Internet domain name in which at least two successive labels of the at least one of said at least one Internet domain name are combined to form a single label." Tsukui also fails to disclose or suggest at least these features of claim 1.

Tsukui fails to disclose or suggest such conditionally converting an Internet domain name into a second format of Internet domain name in which at least two successive labels of the Internet domain name are combined to form a single label. In particular, **Tsukui fails to teach converting** an Internet domain name into a second format **such that at least two successive labels of the Internet domain name are combined to form a single label**.

The Office Action cited column 4, lines 3-65, and Figure 3 of Tsukui. However, there is no disclosure, whatsoever, of a conversion in which two or more successive labels of an Internet domain name of first format would be combined to form a single label of an Internet domain name of second format. Instead, *e.g.* in Figure 3 of Tsukui discusses how to divide an e-mail address into predetermined segments (column 3, lines 64-66). In the process of Tsukui, the address is examined segment by segment by comparing the extracted segments into stored in the backup RAM to find out if the extracted character string is stored in the backup RAM. But, in this process of Tsukui:

1) **No two labels are combined to form a single label**. For example, separate labels "co" and "jp" separated by a dot (*i.e.* "co.jp") **stay as separate labels** (*i.e.* as "co.jp"; *see* column 4 and Figure 4 of Tsukui) in the process of Figure 3; they are not combined to form a single label.

2) **There is no conversion of an Internet domain name of a first format into a second format** in Figure 3 of Tsukui. Instead, only e-mail address segments are extracted for comparison purposes but they, or the complete e-mail address, are not converted into any second format. Even if some segments were stored separately, they would still not constitute the original address in a second format but only incomplete parts of the original address still in the first format.

The Advisory Action asserted that, "Two separate labels are treated as one label in memory. Thus, they are combined." This is clearly an incorrect conclusion. First of all, the Advisory Action has admitted in the above statement that two separate labels actually exist (even if treated together), which makes the statement ambiguous. Secondly, the two separate labels are not combined but clearly stay as separate labels, separated by the dot – and stored that way in Tsukui (*see* column 4, line 22, of Tsukui). Even if the labels "co" and "jp" were treated together, *e.g.* stored, they would still remain two separate labels according to the definition of claim 1. Claim 1 defines "separated" in terms of being separated by dots "... Internet domain name comprising a plurality of successive labels separated by dots ...". In other words, claim 1 clearly defines what a label is and according to that definition, the string "co.jp" includes two labels. The way that labels are stored does not, in any way, change their format (as defined in claim 1). This is simply a logical necessity when the labels themselves stay unchanged, as in Tsukui.

The Advisory Action also argued that "It is noted that no definition of 'format' appears in the claims ...". This assertion is incorrect. Both "a first format" and a "second format" are explicitly defined in the claims.

Claim 1 additionally recites, in part, "supplying the data to the database operations, the supplied data including at least one Internet domain name in the second format." Tsukui fails to disclose or suggest these features of claim 1.

Tsukui fails to suggest supplying any data to any database operations. In addition, as mentioned above, there is no second format of Internet domain name disclosed in Tsukui.

The Office Action cited column 5, lines 40-50, of Tsukui with respect to these features. In this cited paragraph, Tsukui explains how an extracted e-mail can be stored in a divided manner into backup RAM 106. However, the backup RAM is merely a random access memory and as such does not correspond to a database, as has been discussed above. Furthermore, there

is no mention of any database operations in Tsukui. Finally, the e-mail address stored in the backup RAM 106 is not in any second format but is still in the original format. The fact that the address may be stored divisionally (or in a divided manner) does not change the address format *per se*. For example, the e-mail address tsukui@rdmg.mgcs.mei.co.jp would retain its format even if it is stored divisionally because no part of the original address is changed during the storing process according to Tsukui.

Accordingly, for the reasons stated above, it is respectfully submitted that Tsukui fails to disclose or suggest all of the elements of claim 1. Although each of the other claims has its own scope, and although some of the other claims were rejected with the assistance of additional references, at least the same (or similar) clear errors above also apply to those rejections.

For the reasons set forth above, it is respectfully submitted that each of claims 1-11, 15, and 21-27 recites subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that all of claims 1-11, 15, and 21-27 be allowed and that this application be passed to issuance.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

33,125 for

Peter Flanagan, Attorney for Applicants
Registration No. 58,178

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Vienna, Virginia 22182-6212
Telephone: 703-720-7800
Fax: 703-720-7802

PCF:dlh

Enclosures: PTO/SB/33 Form, Notice of Appeal, Petition for Extension of Time, Check No. 000020053